

REMARKS

In the Office Action mailed June 12, 2009, the Examiner rejected claims 33, 34, 36, 40, 41, 53, 59-65. By way of the foregoing amendments and the markings to show changes Applicant has amended claims 33, 36, 59-62, and 65. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art. Applicant respectfully requests entry of these amendments as these amendments put the rejected claims in better form for consideration on appeal or in condition for allowance.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

I. EXAMINER TELEPHONIC INTERVIEW

Applicant would like to thank Examiner Gary Hartmann for the time and courtesy extended to Applicant's representative Daniel Aleksynas during a telephone interview on September 15, 2009. In that interview claim 33 was discussed. Examiner Hartmann indicated that if the last sentence of the claim was deleted and the word "heats" was replaced with "is capable of heating" the amendments would appear to overcome the 35 U.S.C. § 112 rejection, and that he would enter the amendment. Applicant also pointed out that no 35 U.S.C. §§ 102 or 103 rejection was made on the second half of claim 33. Finally, U.S. Patent No. 6,998,101 was discussed where Applicant argued that this reference is not prior art as U.S. Patent Application Publication 2006/0104716 has an earliest priority date of August 16, 2002 and U.S. Patent No. 6,998,101 was filed on July 21, 2003. Examiner Hartmann indicated that this argument appeared to be persuasive.

CLAIM REJECTIONS – 35 U.S.C. § 112

The Office Action rejected claims 33, 36 and 59-65 under 35 U.S.C. § 112 second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Without acquiescence to this suggestion Applicant has amended all of these claims. Applicant respectfully request entry of these amendments as these amendments either place the claims in allowable form or put the rejected claims in better form for appeal.

Applicant disagrees that claim 33 impermissibly contains process steps; however, in the interest of expediting prosecution Applicant has amended claim 33 removing the rejected portion of this claim. Applicant believes that this rejection is moot, and respectfully requests that the claim be allowed as the entire claim is not currently under a 35 U.S.C. §§ 102 or 103 rejection, as discussed below.

Without acquiescing to the suggestion in the Office Action, Applicant has amended claim 36 to remove “is employed and.” Applicant believes this rejection is moot and respectfully requests this amendment is entered and the rejection be withdrawn.

The Office Action rejected claims 59 and 65 stating that the “surface” is not part of the apparatus, and recitations directed thereto are indefinite. Without acquiescence to this suggestion, Applicant has amended the claim to clarify the recitation to the surface. Applicant believes that this amendment renders the rejection moot and respectfully request entry of the amendment and withdrawal of the rejection.

II. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejected claims 33, 34, 36, 40, 53, and 59-65 under 35 U.S.C. § 103 as being unpatentable over Weaver (3,625,489) in view of Wollner et al. (3,311,104), Edo (4,261,669), Goodhard et al. (6,659,684), and either Wiley (6,998,010) or Damp et al. (4,601,605).

a. Lack of Fact Finding

The Office Action does not set forth sufficient fact findings to support the rejections under 35 U.S.C. § 103 of claims 33, 34, 36, 40, 53, and 59-65. “All words in a claim must be

considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Foremost, the Office Action has failed to make any substantive rejection of claim 65. The Office Action has not pointed out where any of the references of record teaches claim 65. Therefore, Applicant respectfully requests entry of the amendment to overcome the 35 U.S.C. § 112 rejection and the claim be allowed.

The Office Action has not shown where the art of record teaches every word of claim 33. Specifically, the Office Action has not shown where any reference teaches:

wherein liquid petroleum gas is supplied through a vaporizer system to form an air/gas premix prior to ignition;
wherein the at least one heater is capable of heating to a depth of 10 mm to 100 mm from the surface to be repaired to an average temperature of 50° C to 200° C for from 5 to 20 minutes.

No rejection has been set forth as to this portion of the claim; therefore, Applicant respectfully requests that the rejection be withdrawn and the claim allowed.

The Office Action has not shown where Goodhard or any other reference of record teaches every word of claim 36. The Office Action simply concludes that the material is prior art without pointing to any art that teaches the material and the thermal properties. Further, Applicant believes that the Office Action did not set forth an appropriate analysis to satisfy the Supreme Court’s requirements from *KSR International co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1396 (2007). The Office has the burden to explicitly analyze:

. . . interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)....

Applicant believes the rejection of claim 36 is a mere conclusory statement absent any “articulated reasoning with some rational underpinning to support the legal conclusions of obviousness.” The Office Action fails to point out with any particularity where any reference teaches “a heater blanket is made of an electrical resistance steel that includes iron, chromium, aluminum, and yttrium.” Therefore, a proper rejection under *KSR* was not made.

b. Lack of Evidentiary support for Fact Finding

The Office action suggests that the sensor of claim 33 is the same sensors taught in Wiley and Damp. However, claim 33 reads, “a sensor for sensing the distance between the at least one heater and the surface to be repaired so that the heating can be controlled by the proximity to the surface to be repaired.” The Office Action then discusses adjusting the height of the heater based upon temperature—not proximity. The Office Action has not shown where either reference teaches the claimed language. Therefore, it is believed that this rejection is moot, and Applicant respectfully request that the rejection be withdrawn.

The Office Action suggests that a controller and a sensor of claims 40, 53, and 62 are inherent. However, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112IV (quoting Ex parte Levy, 17 USPQ2d 1461, 1467 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Here the Office Action has supplied no facts or technical reasoning to support the inherency determination. The Office Action has only concluded that it is inherent without showing that the “characteristic necessarily flows from the teachings of the applied prior art.” Furthermore, the Office Action has not even pointed a single reference of record and claimed that “a controller” is inherent in that reference. Therefore, a proper rejection based on inherency has not been made and Applicants respectfully request that the rejection be withdrawn. Furthermore, Applicant believes that the Office Action did not set forth an appropriate analysis to satisfy the Supreme Court’s requirements from *KSR International co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1396 (2007). The Office has the burden to explicitly analyze:

. . . interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)....

Applicant believes the rejections of claims 40, 53, and 62 are mere conclusory statements absent any “articulated reasoning with some rational underpinning to support the legal conclusions of obviousness.” The Office Action fails to point out with any particularity where any reference teaches a controller or sensor, or where it is inherent in any of the references. Therefore, a proper rejection under *KSR* was not made.

The Office Action suggested that it is well known to position a hot material source in proximity to another material to be heated. The Examiner took Official Notice of this statement, and Applicant respectfully invites the Examiner to put forth evidence that this is well known in the art. MPEP 2144.03. Thus, Applicant respectfully requests entry of these amendments as these amendments put the rejected claims in condition for allowance.

CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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